

REMARKS

Reconsideration of the captioned application as amended herewith is respectfully requested.

The Office Action:

- a) rejected claims 1 – 2, 4 – 6, 9 – 12, 14 – 16, 19, and 22 - 24 under 35 USC §102(b) over United States Patent No. 5,084,278 to Mehta, et al. ("Mehta")
- b) rejected claims 1 – 6, 8, 11 – 16, 17, and 19 - 24 under 35 USC §102(e) over of United States Patent No. 6,139,865 to Friend, et al. ("Friend"); and
- c) rejected claims 1 – 24 under 35 USC §103(a) over Mehta, in view of Friend, and CA 2068366 to Morella ("Morella").

Claims 1, 11, and 19 were amended to highlight novel features of the present invention. Support for these amendments may be found in the Specification as originally filed at, for example, page 4, lines 30 – 35 and page 5, lines 3 – 5, and as such do not introduce new matter into the application.

Claims 9, 10, 18, 20, and 25 were cancelled. New claim 26 was added. Claims 1 – 8, 11 – 17, 19, 21 - 24, and 26 remain pending in this application after entry of this amendment.

The Rejection of Claims 1 – 2, 4 – 6, 9 – 12, 14 – 16, 19, and 22 - 24 under 35 USC §102(b) as Anticipated by Mehta Should Be Withdrawn

Claims 1 – 2, 4 – 6, 9 – 12, 14 – 16, 19, and 22 – 24 stand rejected under 35 USC §102(b) as anticipated over Mehta. Applicants respectfully disagree for the reasons that follow.

Mehta fails to disclose or suggest a coating containing a combination of two different kinds of polymers as claimed herein: "a) an enteric polymer; and b) a water insoluble, cellulosic film forming polymer." Rather, Mehta discloses a long list of many compounds that may be suitable for use in polymeric coating compositions, but fails to point out the need to particularly combine "an enteric polymer" with "a water insoluble, cellulosic film forming polymer" as claimed herein.

Further, Mehta fails to disclose or suggest the use of these particular polymers in a “weight ratio of enteric polymer to water insoluble, cellulosic film forming polymer ... of about 20:80 to about 80:20” as claimed. Although the Office Action referred to the disclosure of a “30 to 70%” range in column 10, lines 50 – 55 of Mehta, this range is between two Eudragit polymers and not between an enteric polymer and a water insoluble, cellulosic film forming polymer as claimed herein.

Rejections under 35 USC §102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. In re Marshall, 198 USPQ 344 (CCPA 1978). In other words, to constitute an anticipation, all material elements recited in a claim must be found in one unit of prior art. Id. The exclusion of a claimed element from a prior art reference is enough to negate anticipation under 35 USC §102 by that reference. Atlas Powder Co. v. E.I. Du Pont de Nemours & Co., 224 USPQ 409 (Fed. Cir. 1984).

Because Mehta fails to disclose or suggest the use of several claimed elements, for example, a “coating comprising a mixture of a) an enteric polymer; and b) a water insoluble, cellulosic film forming polymer” as claimed, and the use of those two polymers at the claimed weight ratio, Applicants respectfully submits that the rejection of claims 1 – 2, 4 – 6, 11 – 12, 14 – 16, 19, and 22 – 24 under 35 USC §102(b) has been overcome and should be withdrawn.

The Rejection of Claims 1 – 6, 8, 11 – 16, 17, and 19 – 24 under 35 USC §102(b) as Anticipated by Friend Should Be Withdrawn

Claims 1 – 6, 8, 11 – 16, 17, and 19 – 24 stand rejected under 35 USC §102(e) as anticipated over Friend. Applicants respectfully disagree for the reasons that follow.

Friend fails to disclose or suggest a coating containing a combination of two different kinds of polymers as claimed herein: “a) an enteric polymer; and b) a water insoluble, cellulosic film forming polymer.” Rather, Friend discloses a long list of many compounds may be suitable for use in polymeric coating compositions, but fails to point out the need to particularly combine “an enteric polymer” with “a water insoluble, cellulosic film forming polymer” as claimed herein. See Friend, Column 7, lines 22 – Column 8, line 7.

Further, Friend fails to disclose or suggest the use of these particular polymers in any particular weight ratio, let alone a “weight ratio of enteric polymer to water insoluble, cellulosic film forming polymer ... of about 20:80 to about 80:20” as claimed.

Rejections under 35 USC §102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. In re Marshall, 198 USPQ 344 (CCPA 1978). In other words, to constitute an anticipation, all material elements recited in a claim must be found in one unit of prior art. Id. The exclusion of a claimed element from a prior art reference is enough to negate anticipation under 35 USC §102 by that reference. Atlas Powder Co. v. E.I. Du Pont de Nemours & Co., 224 USPQ 409 (Fed. Cir. 1984).

Because Friend fails to disclose or suggest the use of several claimed elements, for example, a “coating comprising a mixture of a) an enteric polymer; and b) a water insoluble, cellulosic film forming polymer” as claimed, and the use of those two polymers at the claimed weight ratio, Applicants respectfully submits that that the rejection of claims 1 – 6, 8, 11 – 16, 17, and 19, and 21 – 24 under 35 USC §102(b) has been overcome and should be withdrawn.

The Rejection of Claims 1 –24 under 35 USC §103(a) as Being Unpatentable Over Mehta in view of Friend and Morella Should Be Withdrawn

Claims 1 –24 stand rejected under 35 USC §103(a) as being unpatentable over Mehta in view of Friend and Morella. Applicants respectfully disagree for the reasons that follow.

Applicants respectfully submit that the claims are patentable over Mehta and Friend for the reasons set forth above. Applicants further respectfully submit that the claims have already been found allowable over Morella prior to this Amendment by the Decision of the Board of Patent Appeals and Interferences mailed on 29 September 2004 (“Decision”), a copy of which is attached. In particular, the Decision said

We find that Example 3 of the Morella reference does not have the dissolution profile as required by the claimed invention....

See Decision, page 4. Therefore, even if one were to properly combine Morella with Friend and Mehta, the Board has already clearly found that there was no “evidence or argument, to

demonstrate why the ordinary artisan would have been motivated to modify the particle having the dissolution profile shown [sic] Figure 3 of Morella to obtain a particle having the claimed dissolution profile. 'Conclusory statements' as to teaching, suggestion or motivation to arrive at the claimed invention 'do not adequately address the issue of obviousness.' Thus, it is clearly evident that the resulting combination proposed in the Office Action would not possess all of the claimed elements, and that the rejection of claims 1 – 24 under 35 USC §103(a) has been overcome and should be withdrawn.

Conclusion

It is submitted that the foregoing amendments and remarks place the case in condition for allowance. A notice to that effect is earnestly solicited.

In the event that all of the claims are not in condition for allowance, Applicants respectfully request for an interview with the Examiner before the preparation of the next Office Action.

Respectfully submitted,

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Attachment: Board of Patent Appeals and Interferences Decision